

REMARKS

In the Office Action mailed March 30, 2011, the Examiner:

(1) rejected claims 30, 31, and 36-55 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,254,558 to Hinkle et al. ("Hinkle")¹ in view of U.S. Patent No. 6,989,820 to Baker et al. ("Baker") and European Patent No. 1,164,519 to Ahmed ("Ahmed"); and

(2) rejected claims 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Hinkle, Baker, Ahmed, and further in view of U.S. Patent No. 6,718,535 to Underwood ("Underwood").

By this Reply, Applicant does not amends any claims. Claims 30-55 remain pending and under current examination.

I. 35 U.S.C. § 103 Rejection of Claims 30-31 and 36-55

Applicant respectfully traverses the rejection of claims 30-31 and 36-55 under 35 U.S.C. §103(a) as obvious over Hinkle in view of Baker and Ahmed. A *prima facie* case of obviousness has not been established with respect to these claims.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious...[R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 8 (July 2010) (internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1,

¹ In the Office Action, the Examiner continues to list U.S. Patent No. 7,254,288 which is a patent titled "Corner Cube Depolarizer" to Kalibjian. In this Amendment, Applicant again assumes that the Examiner meant to cite U.S. Patent No. 7,254,558, which is listed in the PTO-892 form, to Hinkle et al.

148 USPQ 459 (1966). ... The factual inquires...[include determining the scope and content of the prior art]...[a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Amended independent claim 30 recites, in part, “associating, by the computer, a plurality of optional states with a selected invoice in the second set of invoices; presenting the selected invoice with the plurality of optional states; [and] receiving a selection of a first state, among the plurality of optional states, for the selected invoice.” The cited references do not teach, suggest, or render obvious at least these elements of independent claim 30. In fact, the Office Action conceded that Hinkle “fails to disclose” the above-cited limitations of claim 30. Office Action, pp. 3-4. Furthermore, contrary to the Examiner’s allegations, Baker and Ahmed, alone or in combination, do not cure the deficiencies of Hinkle.

Baker discloses “[a]n automated administration system for providing state-based control of soft-labeled keys (SLKs) in a wireless terminal or other type of communication system terminal.” Baker, abstract. In particular, Baker implements “state control logic for use in maintaining or otherwise processing a state transition table.” Baker, col. 4, ll. 44-47. The Office Action interprets Baker’s “states” to be corresponding to the claimed “optional states.” Office Action, pp. 3-4. This interpretation is incorrect. Baker has nothing to do with “processing invoices.” Baker’s “states” associated with its “communication terminals” such as “wireless handsets,” do not constitute or suggest the claimed “plurality of optional states [associated] with a selected invoice in the second

set of invoices,” as recited by claim 30. Indeed, the word “state” is used in a completely different context in Baker than claim 30. For example, Baker discloses that “when a conference feature is administered on the SLKs of the wireless terminal 122, a consequential state is created by the system,” where “[t]his state represents those events that are legitimate for the user ..., e.g., add another member to the conference, drop a member from the conference, transfer, etc.” Baker, col. 5, ll. 48-54. Therefore, relying on Baker’s “state” for the teaching of “plurality of optional states” or the “first state” recited in claim 30 is a piecemeal characterization of Baker as well as Applicant’s claim.

Because Baker fails to teach or suggest the claimed “plurality of optional states” or the “first state,” Baker also fails to teach or suggest “associating, by the computer, a plurality of optional states with a selected invoice in the second set of invoices,” “presenting the selected invoice with the plurality of optional states,” and “receiving a selection of a first state, among the plurality of optional states, for the selected invoice,” as recited by amended claim 30.

Applicants also submit that there is no motivation from within Baker to combine it with Hinkle or Ahmed. The techniques disclosed by Baker are used in a “communication application in which it is desirable to control terminal state in a processing-efficient and bandwidth-efficient manner,” (Baker, col. 3, ll. 30-33) and has nothing to do with Applicant’s “method for processing invoices,” or the collection methods taught by Hinkle and Ahmed. Therefore, Baker is nonanalogous art, and there would be no motivation in Baker to modify it to arrive at Applicant’s claimed invention.

Ahmed, cited merely for its alleged teaching of “a set of invoice which are due within a specified time period,” see Office Action, p. 4, does not teach or suggest the “associating,” “presenting,” and “receiving” elements of claim 30.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and independent claim 30. Consequently, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Accordingly, the Office Action has not met the burden of establishing a *prima facie* case of obviousness of claim 30, and thus, the rejection of this claim under 35 U.S.C. § 103(a) must be withdrawn.

Independent claims 54 and 55, while each of a different scope, include elements similar to those discussed above with respect to claim 30 and are allowable for reasons at least similar to those presented above with respect to claim 30. Accordingly, a *prima facie* case of obviousness has not been established for independent claims 54 and 55 for at least reasons similar to those discussed above. Therefore, the Examiner should also withdraw the rejection of claims 54 and 55 under 35 U.S.C. § 103(a) based on Hinkle, Baker, and Ahmed.

Claims 31 and 36-53 depend from independent claim 30. Therefore, a *prima facie* case of obviousness has not been established for claims 31 and 36-53 at least due to their dependence and the Examiner should withdraw the rejection of these claims under 35 U.S.C. § 103(a).

II. 35 U.S.C. § 103 Rejection of Claims 32-35

Applicant traverses the rejection of claims 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Hinkle, Baker, Ahmed, and Underwood. Underwood, cited by the Office Action merely for the alleged teaching of “invoices of special importance,” does not cure the deficiencies of Hinkle, Baker, and Ahmed. That is, Hinkle, Baker, Ahmed, and Underwood, taken alone or in combination, do not teach or suggest the “associating,” “presenting,” and “receiving” elements of amended independent claim 30.

For at least the above reasons, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and amended independent claim 30. Accordingly, no *prima facie* case of obviousness has been established with respect to claims 32-35 at least because of their dependency from claim 30. Therefore, Applicant respectfully requests that the Examiner withdraw the rejections of claim 32-35 under 35 U.S.C. § 103(a).

III. CONCLUSION


In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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